

## **REMARKS**

Applicants thank the Examiner for not making the last Office Action final.

### **The Rejections Under 35 USC § 102**

US '425 does not teach or suggest the presently claimed invention having a substrate as recited in claim 1, i.e., natural or synthetic mica, metal flakes, glass flakes, TiO<sub>2</sub> flakes or iron oxide flakes.

The carrier in US '425 is not a finely divided substrate, but instead are described on column 4, lines 58-63, as one or more disks, cylinders, or other rotationally symmetric bodies, which preferably consist of one or more continuous metal belts.

Moreover, none of the carriers in US '425 are made of material recited as a substrate in the claims.

Additionally, claim 1 is further clarified to explicitly recite therein the definition of “directly” from the specification, that there is no interlayer between the substrate and the impermeable coating.

The Office Action alleged that “the meaning of the ‘directly on the carrier’ is not clear as to whether another intervening layer is precluded, since the claimed language is open to additional elements.

Applicants assume that the open ended term “comprising” might have been the reason for the allegation.

Generally, the use of the transitional phrase “comprising” does not exclude additional, unrecited steps or agents, e.g., layers. This presumption, however, “does not reach into each of the [claimed] steps to render every word and phrase therein open-ended—especially where ... the patentee has narrowly defined the claim term.” See *Dippin’ Dots, Inc. v. Mosey*, 476 F.3d 1337, 1343 [81 USPQ2d 1633] (Fed. Cir. 2007), and also *University of Texas v. BENQ America Corp.*, 87 USPQ2d 1437 (Fed. Cir. 2008). Accordingly, the term “comprising” cannot be used to alter the scope of a particular explicit claim limitation, such as “directly” or now in its even further clarified form “directly ... without the presence of an interlayer between the substrate and the impermeable coating” to be open to such an additional interlayer. “‘Comprising’ is not a weasel word with which to abrogate claim limitations.” See *Moleculon Research Corp. v. CBS, Inc.*, 793 F.2d 1261, 1271, 229 USPQ 805, 812 (Fed.Cir. 1986) and *Spectrum Int’l, Inc. v. Sterilite Corp.*, 164 F.3d 1372, 1380 [49 USPQ2d 1065] (Fed. Cir. 1998).

The Office Action simply reads out or gives no weight to the explicitly recited term “directly” in the claims in favor of the general presumption associated with the term “comprising.” However, a general presumption under applicable law clearly must yield to an explicit limitation in the claims.

Thus, the term “comprising” in the present case does not open up the claimed finely divided hard bodies to embodiments where an interlayer is present between the substrate and the impermeable coating. It however is open to other layers, e.g., an aftercoating on top of the impermeable coating, etc.

US ‘425 teaches plane-parallel structures where, e.g., silicon oxide is condensed onto a carrier, which condensed silicon oxide detaches from the carrier to form the product. The Office Action alleges that “there is nothing precluding applicants material to ‘separate later.’” However, such is completely irrelevant to the patentability of the claims of the present application. Speculation as to whether later separation may occur is irrelevant as the prior art does not teach what is recited in the present claims. The claims recite finely divided hard bodies where an impermeable coating is “present directly on” a finely divided substrate. US ‘425 simply does not teach or even remotely suggest the presently claimed invention where a finely divided substrate has directly thereon a material having a hardness  $\geq 7$  on the Mohs hardness scale.

Furthermore, US ‘425 does not teach the claimed process for the preparation of the finely divided hard bodies recited in claim 13. US ‘425 only teaches very specific processes for the production of silicon suboxide ( $\text{SiO}_y$ ) structures, which is recited in claim 1 therein, for the conversion of these structures to silicon dioxide structures, which is recited in claim 9 therein, and for the conversion of a part of a surface of silicon suboxide structures to silicon carbide, which is recited in claim 12 therein, which is directed to carburizing.

As such, neither the claimed products nor the claimed methods are anticipated or even obvious from the disclosure of US ‘425.

Reconsideration is respectfully and courteously requested.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

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